

**Question Q217**

**National Group:** AIPPI Indonesia

**Title:** **The patentability criterion of inventive step /non-obviousness**

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**Questions**

**I. Analysis of current law and case law**

The Groups are invited to answer the following questions under their national laws:

**Level of inventive step / non-obviousness**

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

Standard for inventive step/non-obviousness in our jurisdiction is based on the provisions stipulated in the Article 2 par 3-4 of Indonesian Patent Law no. 14/2001. An Invention shall be considered to involve an inventive step if said Invention does not constitute something that is obvious to a person skilled in the art. The standard of evaluation of whether or not an Invention constitutes something that is obvious must be made taking into account the state of the art at the time the Application is filed or which has existed at the time the first Application was filed, in case the Application is filed on the basis of a Priority Right.

In summary the standard for non-obviousness is that it involves the skill of the person skilled in the art, and the state of the art at the time the application is filed.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

No, it has not changed.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

There is no official examination guidelines published by the authority on inventive step. However, during seminar or training wherein the sources/speakers come from

Indonesian Patent Office, it could be seen that the examination guidelines of the Patent Examiner basically referred to the examination guidelines from WIPO and European Patent Office.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

Practically, the standard is the same.

#### **Construction of claims and interpretation of prior art**

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

The claims in our jurisdiction are construed in two-part form claims or one parts form claims. They are read literally and should be understood by a person skilled in the art. Therefore, they should be clear as individual and in overall, as the claims define the subject matter which is wished to be protected.

6. Is it possible to read embodiments from the body of the specification into the claims?

It is possible to read embodiments from the body of the specification in point of view of the dependent claim.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

The prior art interpreted in claims if the claim is construed in two-part form claims. In such form, the prior art is read literally. In one part form claims the interpretation of prior art would be understood by a person skilled in the art by reviewing the background of invention in the description. In the background section, the disclosure of prior art should be cited literally. The disclosure of the prior art includes any information contained implicitly which is understood by the people skilled in the art after reading it.

8. Do the answers to any of the questions above differ during examination versus during litigation?

Practically, the answers are the same.

#### **Combination or modification of prior art**

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes, it is proper in our jurisdiction to find lack of inventive step over a single prior art. Argument and common general knowledge is to be considered.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

It is possible to combine two or more prior art references, provided that the combination of the disclosure of the prior arts are obvious for the people skilled in the art. The prior art references are the relevant documents found during search, including relevant documents submitted by any third party during the publication period, so as the disclosure of the closest prior art is defined.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

The disclosure of closest prior art may take account one of the below:

- disclose the effect of technical feature, the objective or the use of it which is the most similar with the claimed invention, or
- has the largest number of common technical features with the invention and able to perform the functions of the invention.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

As cited in points 10-11 above, it is required and surely permitted to combine two or more prior art references to show lack of inventive step. The Standard is the same when two references are combined.

13. Do the answers to any of the questions above differ during examination versus during litigation?

Practically, the answers are the same.

### **Technical Problem**

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The technical problem to be solved in the invention plays role in determining inventive step, as the improvement of the invention, and/or alternative invention are derived from the solution of technical problem in which it should be non-obviousness for the people skilled in the art.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem in the prior art must to be disclosed in the specification to the degree in which such problem is indeed required to be solved and it has been a demand in the market to seek the solution of that. From that point, the invention must come with the solution of such technical problem in which it should be non-obviousness for the people skilled in the art.

### **Advantageous effects**

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantages play role in determining inventive step, as the advantages effects are the solution of the technical problem of the prior art which differ it from the prior art. The advantages effects are also the improvement of the prior art, or the alternative solution of the technical problem of the prior art in which it should be non-obviousness for the people skilled in the art.

17. Must the advantageous effects be disclosed in the as-filed specification?

The advantages effects must be disclosed in the as filed specification.

18. Is it possible to have later-submitted data considered by the Examiner?

Any amendment of the specification or latter-submitted data may be considered by the Examiner as long as such amendment (description and/or the claims) do not expand the scope of Invention applied for the original Application (Article 35 of Indonesian Patent Law no. 14/2001).

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

The advantageous effect must be real enough for the people skilled in the art after reading it as such advantageous technical effects must be capable of being applied industrially. The paper and examples which derived from the scientific test and/or data related with the invention which supports the advantages effects are acceptable. The examples and paper should be understood by the people skilled in the art.

20. Do the answers to any of the questions above differ during examination versus during litigation?

Practically, the answers are the same.

### Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?

No.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

23. Is there any difference in how teaching away is applied during examination versus in litigation?

### Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

No.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

26. Do the answers to any of the questions above differ during examination versus during litigation?

## Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

If yes, please describe these issues, tests, or factors.

No.

## Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

The test for inventive step in our jurisdiction is the "problem-solution approach" in order to decide whether an invention involves an inventive step. The approach consists in:

1. identifying the closest/most relevant prior arts; which disclose the effect of technical feature, the objective or the use of it which is the most similar with the claimed invention, or has the largest number of common technical features with the invention and able to perform the functions of the invention.
2. disclosing the difference between/among the prior art(s) and invention, and the subject matter of the claimed invention. Determining the objective technical problem from the distinguishing features, in the view of the most relevant prior arts, the technical problem which the claimed invention addresses and successfully solves; and
3. examining whether or not the claimed solution to the objective technical problem is obvious for the skilled person in view of the state of the art in general. If the skilled person would have been prompted to modify or to adapt the prior art in such a way as to arrive at something falling within the terms of the claims, then the invention does not involve an inventive step.

29. Does such test differ during examination versus during litigation?

Practically, the test is the same.

## Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

N/A

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

## Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

N/A

33. If yes, is this problematic?

## II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?  
Yes, harmonization for minimum basic standards for inventive step that would be universally acceptable.
35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

Yes, it is possible to find some minimum basic standards for inventive step that would be universally acceptable. For instance, definitions of inventive step/non-obviousness, criteria of people skilled in the art, minimum requirement of prior art used as the consideration for the inventive step (number of prior art, aspects in support of inventive step etc).

For further detailed/customized standards to complete such minimum standard will depend on the each jurisdiction's discretion, as it evolved with the technical/industrial evolution in each jurisdiction. We shall refer as well to common rule of Paris convention as the right to grant a patent is absolutely the right of each country/jurisdiction.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

An Invention shall be considered to involve an inventive step if, having regard to the state of the art, it would not have been obvious to a person skilled in the art, at the time the Application claiming the invention is filed or which has existed at the time the first Application was filed, in case the Application is filed on the basis of a Priority Right.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

Problem solution approach (by taking into account the close relation of technical fields and advantageous effects).